REMARKS

Claims 1-17 and 20-26 are currently pending in the subject application and are presently under consideration. Claims 1, 4, 9, 17, 20, 21 and 24 have been amended herein to clarify various aspects of the subject invention and place the application in condition for allowance. No new matter has been added that would require the Examiner to conduct a new search. A complete list of claims in revised amendment format can be found at pages 2-6.

Entry of the aforementioned amendments and allowance of the subject patent application is respectfully requested in view of the following comments.

I. Rejection of Claims 1-17 and 20-26 Under 35 U.S.C. § 103 (a)

Claims 1-17 and 20-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lupien, *et al.* (U.S. 5,689,652). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons.

Lupien, *et al.* fails to disclose, teach or suggest each and every claim limitation. Furthermore, one of ordinary skill in the art at the time the subject invention was made and who had no prior knowledge of the claimed business system and methodology would not be motivated to modify Lupien, *et al.* to produce the subject invention as claimed.

> To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** *See* MPEP §706.02(j) The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and ***not based on applicant's disclosure.*** *See In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Independent claims 1, 9, 17, 20, 21, and 24 as amended recite matching ***price and non-price buying criteria.*** Lupien, *et al.*, discloses an electronic crossing network which is merely a version of a common volume buying scheme where seller sells a particular quantity of products

at a fixed price as disclosed in the background section of the subject application. More particularly, in Lupien, *et al.* matching of buyers and sellers is based on the density profiles of both buyers and sellers, which indicate satisfaction with a certain ***amount*** of stock at a certain ***price*** (*e.g.*, 10,000 IBM at $64). One drawback of such a buying scheme is that it fails to provide buyers with a choice between a ***variety of different buying criteria*** that may be just as important or more important to the buyer than price (page 1, lines 18-22). For instance, a buyer of products and services may be concerned with such non-price criterion as faster deliver time, goods with a minimum number of defects, and longer warrantees (See page 1, line 23 through page 2, line 2, and page 3, line 2 through page 4, line 2). Lupien, *et al.* is not concerned with non-price information, at least because Lupien, *et al.* deals with intangible financial interests such as equity securities, rather than products and services, where the only significant criterion is price per volume (*e.g.*, 10,000 IBM at $64). In view of the intended purpose of Lupien, *et al.* a person of ordinary skill in the art would not seek to modify the financial crossing network of Lupien, *et al.* to match non-price criteria, such as warranty length, and minimum number of defects. Accordingly, Lupien, *et al.* does not teach or suggest either explicitly or implicitly matching non-price buyer criteria. Thus, claims 1, 9, 17, 20, 21, and 24 (as well as claims 2-8, 10-16, 22, 23, 25, and 26 depending thereon) are allowable for at least this reason.

Furthermore, applicant's representative respectfully disagrees with the Examiner's assertion that it would be have been obvious to a person of ordinary skill in the art to modify Lupien, *et al.* to provide a business methodology executed over the Internet *via* a plurality of computers at least because Lupien, *et al.* teaches away from such application.

> Obviousness can only be established where there is some teaching or suggestion for the purposed modification or combination. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed.Cir. 1992). ***A reference that teaches away from the art is a per se demonstration of a lack of prima facie obviousness.*** *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997). A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130 (Fed. Cir. 1994); *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999) (Emphasis Added).

Lupien, *et al.* teaches that one of the main advantages of employing crossing networks is to preserve the anonymity of buyers and sellers (See col. 1 lines 60-63, and col. 2 lines 44-49). Thus, one of ordinary skill in the art upon reading Lupien, *et al.* would be discouraged from providing a business transaction methodology over the Internet as claimed by the present application. Accordingly, claims 1-17 and 20-26 are non-obvious and allowable for at least this reason.

Additionally, it should be noted that claim 13 provides an additional ground for patentability above and beyond the grounds described above with respect to independent claim 9 from which it depends. In particular, Lupien, *et al.* fails to teach or suggest a system wherein at least one buyer receives a discount on a purchase based on a previous purchase made by at least one buyer, as recited by claim 13. As described *supra*, Lupien, *et al* provides for a crossing network that facilitates trading of financial interests such as stocks and bonds. There is no teaching or suggestion that a buyer of a stock, for example, should receive a discount on presently purchased stock based on a previous purchase of stock. Accordingly, claim 13 is allowable for at least this additional reason.

Furthermore, Lupien, *et al.* teaches away from the limitations contained in claims 15, 16, 22, and 25. Those claims recite allowing a seller to ***review buyer and seller defined criteria*** (claims 15 and 16), and allowing buyers to ***view the deals via*** a remote computer (claims 22 and 25). However, Lupien, *et al.* teaches that one of the main advantages of employing crossing networks is to preserve the anonymity of the buyers and sellers (See col. 1 lines 60-63, and col. 2 lines 44-49). Thus, one of ordinary skill in the art upon reading Lupien, *et al.* would be discouraged from allowing buyers and sellers to view deals and buyer and seller defined criterion. Accordingly, claims 15, 16, 22, and 25 are allowable at least for this additional reason.

In view of the foregoing, claims 1-17 and 20-26 are believed to be allowable. Therefore, withdrawal of this rejection and allowance of the subject application is hereby respectfully requested.

II. Conclusion

The present application is believed to be condition for allowance in view of the above amendments and comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

AMIN & TUROCY, LLP

Himanshu S. Amin
Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone: (216) 696-8730
Facsimile: (216) 696-8731